

Response to Office Action
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Customer No. 33354

REMARKS

I. Interview Summary

On April 12, 2007, Applicant's attorney called Examiner Winner for clarification of the status of claims 8, 12, 14 and 18. On April 13, Examiner Winner clarified that claims 8, 12, and 18 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and that the indicated allowability of claim 14 is withdrawn in view of Niklasson.

II. Claim Status

Claims 1-21 are pending in the application. Claims 20 and 21 are allowed. In light of Examiner Winner's clarification, claims 1, 4-6, 7, 9-11, 13-17 and 19 are rejected. Claims 2-3, 8, 12 and 18 are objected to.

III. Claim Rejection Under 35 USC §102(b)

A. **Niklasson Does Not Anticipate Claims**

The Examiner has rejected claims 1, 4-6, 9-11, 13-16 and 19 as being anticipated by U.S. Pat No. 6,241,268 issued to Niklasson. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2nd 1051 at 1053 (Fed. Cir. 1987). To anticipate, all limitations of the claim must be found in the reference or be "fully met" by it. *Lalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983).

B. **Niklasson Does Not Anticipate Claims 1 and 13**

1. **Attachment 20 Is Not Between the Pushrim and the Wheel**

Applicants' independent claims 1 and 13 require an insert fit between the pushrim and the wheel. The Examiner provided a figure in the office action to indicate which Niklasson part the Examiner deemed the insert ("Examiner's

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Figure"). That figure indicates that the Examiner believes that Niklasson's attachment 20 is an insert. To more easily compare Applicants' insert with Niklasson's attachment 20, Applicants have added additional labels to the Examiner's Figure using Niklasson's wording and part numbers (the Modified Examiner's Figure"), attached. Specifically, Applicants indicate Niklasson's attachment 20, and rim 19 of the wheel 3. See also Niklasson Fig 6.

The Examiner argues that attachment 20 is an insert. Applicant's disagree, as explained below. However, even assuming, *arguendo* that attachment 20 is an insert, attachment 20 is not fit between the *pushrim* and the wheel. Instead, attachment 20 is fit between the *tire* 27 and the rim 19 of the wheel 3.

Therefore, Niklasson does not disclose an insert between the pushrim and the wheel, and Niklasson does not anticipate Applicants' claims. Applicants respectfully request that this rejection be withdrawn.

2. Niklasson Does Not Disclose a Compressible Insert

Applicants' claims 1 and 13 require that the insert be compressibly fit between the pushrim and the wheel. As explained above, attachment 20 is not fit between the pushrim and the wheel. However, even assuming, *arguendo*, that attachment 20 is an insert and is fit between the pushrim and the wheel, it is not compressibly fit. As Niklasson explains,

The outer end 20A of each attachment 20 is bent back on itself 21 for this purpose so as to enclose one edge 22 of the rim and to be securely clamped to the wheel 3 by the tire 27, and so as to be capable of further attachment by riveting or screwing to the rim. The opposite inner end 20B of the attachment 20 is also bent back on itself 23 so that it is able to make contact with the upper side 10A of the finger guard 10 and to be riveted in place or securely fixed to it with a screw 24.

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When the tire 27 is inflated with air, *the tire presses against the attachment 20, 21 and secures it additionally, preferably against a thickened part 28 on the wheel rim.*

Niklasson column 2, lines 30-41 (emphasis added).

Thus, it is clear that attachment 20 is attached at both ends by rivet or screw, or as shown in Fig. 9, bolt and hex nut. Further, attachment 20 is not compressible, instead being a solid "z-shaped angle piece." Niklasson, column 2 line 25. Therefore, it cannot be compressibly fit between the pushrim and wheel. In contrast, Applicants' insert is compressibly fit – made so for convenient installation between already-attached wheel and pushrim. See Specification p.3, Summary, and p.5, ¶2. Applicant's insert is made of elastic material, so that it is easily compressed between the pushrim and wheel during installation, and then expands to compressibly fit between the wheel and pushrim. *Id.* The ease of assembly and self-centering is more clearly recognized by comparing Applicant's Fig. 1 (with compressible insert) to Fig. 2 (prior art without insert).

Niklasson does not disclose that attachment 20 is compressibly fit between the wheel and the pushrim, instead requiring mechanical attachments such as screws, rivets, or bolts. Therefore, Niklasson does not disclose an insert that is compressibly fit as claimed by Applicants, and Niklasson does not anticipate Applicants' claims. Applicants respectfully request that this rejection be withdrawn.

3. Niklasson Does Not Disclose a Drive-Actuating Insert

Applicants' claims 1 and 13 require an insert fitted between the pushrim and the wheel. Applicant's insert is used, in the words of Niklasson, as a "drive-actuating surface," and is therefore shaped to accommodate portions of the hand, preferably with a concave shape to accommodate the thumb. Specification at p. 5, ¶2; Figs. 5 and 6. The insert also has a gripping texture, which provides for improved pushing. Specification at p. 5, ¶3.

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However, attachment 20 of Niklasson is not a drive-actuating surface. Instead, Niklasson's drive actuating surface is indicated as part 6. Applicants indicate attachment 20 and drive actuating surface 6 in the Modified Examiner's Figure. See also Niklasson Fig 6. As now more clearly shown in the Modified Examiner's Figure, the attachment 20 is not a drive actuating surface. Instead, attachment 20 functions only to attach the drive actuating surface 6 to the rim 19. Therefore, the attachment 20 does not function as a drive-actuating insert.

Because Niklasson does not disclose an element that is functionally equivalent to Applicant's insert, Niklasson does not disclose each and every limitation as set forth in the claims. Therefore, Niklasson does not anticipate Applicants' claimed invention and Applicants respectfully request that this rejection be withdrawn.

C. Niklasson Does Not Anticipate Claims 4-6, 9-11, 14-16 and 19

1. Based on Allowable Base Claim

Claims 4-6, 9-11, 14-16 and 19 are dependent on claims 1 and 13. As explained above, Applicants' believe that claims 1 and 13 are not anticipated by Niklasson. Therefore, the Examiner is also requested to withdraw his rejection of dependent claims 4-6, 9-11, 14-16 and 19 based on their dependency on an allowable base claim.

2. Need More Detail to Fairly Reply

In the event these dependent claims are not allowed, Applicants respectfully point out that the Examiner did not set forth with particularity the teachings of the prior art relied upon to reject the claims, with reference to the relevant column or page number(s) and line number(s) where appropriate. MPEP §706.02(j)(A). Therefore, Applicants respectfully submit they do not have a fair opportunity to reply. MPEP §706.02(k). Applicants request that the rejections be

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withdrawn or, alternatively, that the Examiner set forth with particularity the teachings of the prior art relied upon to reject the claims.

IV. Claim Rejection Under 35 USC §103

A. DeSouza Arguments Not Addressed

Examiner did not address Applicants' arguments why U.S. Pat No. 5,938,184 issued to DeSouza is not analogous art, other than to say that they are moot in view of reference to Niklasson. However, because DeSouza is cited again in this office action, Applicants believe that those arguments are not moot. Therefore, Applicants respectfully request that, if the §103 rejection is not withdrawn, that the Examiner explain in his next office action how DeSouza would have commended itself to an inventor's attention in considering the problems of the comfort and efficiency of wheelchair pushrims. See MPEP §2141.01(a). Applicants renew their arguments below that DeSouza is not analogous art.

B. DeSouza Not Analogous

The Examiner has rejected claims 7 and 17 as being obvious in light of Niklasson in view of DeSouza. In order to determine whether an invention is obvious in light of prior art, the Patent Office should make several basic factual inquiries, including the scope and content of the prior art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The scope of the prior art should include only analogous prior art. MPEP §2141.01(a). In general, in order for a reference to be considered analogous prior art, the reference must either be in the field of applicant's endeavor or, if not, be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992) (holding that fasteners for garments are not analogous art for an obviousness rejection of fasteners for a hose clamp); see also *In re Clay*, 966 F. 2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). Moreover, it is

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also necessary that a person of ordinary skill, seeking to solve a particular problem, would reasonably be expected or motivated to look to the allegedly analogous technology. *In re Oeticker*, 24 USPQ2d at 1446.

Applicants' field of endeavor is wheelchairs. The stated objectives of their work are concerned with solving problems of the comfort and efficiency of wheelchair pushrims. See Applicants' Specification p. 3, ¶2. DeSouza is concerned with solving problems of how to more easily fabricate fence posts. See DeSouza column 2, lines 32-33. Thus, DeSouza is not in Applicants' field nor reasonably pertinent to the particular problem with which the inventors were concerned, and a person skilled in the art of wheelchairs would not reasonably be expected or motivated to consider fence post fabrication in solving the problems at issue, namely hand rim comfort and efficiency.

Consequently, DeSouza cannot be considered analogous art and, accordingly, there is no motivation to combine DeSouza and Niklasson. Therefore, no *prima facie* case of obviousness has been established. Applicants respectfully request that this rejection be withdrawn.

C. Niklasson Does Not Teach or Suggest a Claimed Element

The Examiner has asserted that Niklasson teaches all of the claimed elements of Applicants' invention, except for a rib to improve structural strength. A claim is *prima facie* obvious only if the prior art reference teaches or suggests all of the claim limitations. MPEP §2143. Assuming *arguendo* that DeSouza is analogous art, the cited references fail to teach an element of Applicants' claimed invention.

Applicants' claims 7 and 17 require an insert that is compressibly fit between the pushrim and wheel. However, neither Niklasson nor DeSouza teach or suggest an insert that is compressibly fit between the pushrim and wheel. The arguments of Section III are incorporated herein. The cited references fail to teach or suggest all of the claim limitations and a *prima facie* case of

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obviousness has not been made. Therefore, Applicants respectfully request that this rejection be withdrawn.

V. Conclusion

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance. Applicants respectfully request that the Examiner allow the application to proceed to issuance.

6/28/07
Dated

Respectfully submitted,


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